

Appl. No. 10/617,572  
Amdt. Dated July 20, 2005

Attorney Docket No.: BAT-102  
Reply to Office Action of March 21, 2005

**REMARKS:**

**SPECIFICATION AMENDMENTS**

The Applicants have amended the Abstract of the disclosure to implement minor typographical and grammatical corrections, including one requested by the Examiner. The Applicant submits 5 that these amendments make explicit that which was implicit in the specification as filed. As such, no new matter has been entered with these amendments.

**CLAIM AMENDMENTS**

To expedite prosecution, claim 1 has been amended to recite that the first and second elements have the same focal length in their respective first states. Support for this feature can be found in 10 the specification at page 7, lines 10-16. In addition, to expedite prosecution claim 5 has been amended to recite that the switchable elements for a stack of thin lenses. Support for this feature can be found in the specification as discussed below. As such, no new matter has been entered with this amendment. Claims 29, 30, 31, 32, 33, 34, 35, 36, 37, 38 and 39 have been newly 15 added. The Applicants submit that support for the features of claim 29 and 35 can be found in the specification at page 3, lines 3-12. Support for the features of claim 30 can be found in the specification as originally filed at page 6, lines 7-10. The Applicants submit that support for the features of claim 31 can be found in the specification as originally filed at page 15, lines 29-31. The features of claims 32 and 33 can be found at page 7, lines 10-16. The features of claim 34 20 can be found at the section bridging page 5, line 24 to page 6, line 10. The features of claim 36 can be found in the specification at page 5, line 25 to page 6, line 6. The features of claim 37 can be found at page 8, lines 10-13. The features of claim 38 can be found at the section bridging 25 page 8, line 19 to page 9, line 3. The features of claim 39 can be found at the section bridging page 8, line 19 to page 9, line 7. The features of claim 40 can be found at page 3, lines 3-12 and at page 15, lines 25-31. The features of claim 41 can be found at page 8, lines 18-20. As such, no new matter has been added with these amendments. The Applicants further submit that these 30 amendments provide a desired scope of protection and are not being done for any reason related to patentability and the amendments do not narrow any limitation of any other claim within the meaning of the decision in *Festo*.

30

Appl. No. 10/617,572  
Amdt. Dated July 20, 2005

Attorney Docket No.: BAT-102  
Reply to Office Action of March 21, 2005

#### ELECTION/RESTRICTIONS

The Examiner has withdrawn claims 19-20 and 25-26 as being drawn to non-elected Species II.

The Examiner states that Species I and Species II are patentably distinct because the former is drawn to a variable focus lens assembly comprising a plurality of switchable optical elements, whereas the latter is drawn to a specific method of making a single switchable element.

5 The Applicant traverses the requirement on the grounds that it is improper since the Examiner has not met his burden under MPEP 816 to give reasons for his holding of distinctness. The Examiner has set forth only a conclusion that the two species are distinct and has set forth no particular reasons that he has relied on in holding that the two species are patentably distinct.

10 MPEP 816 clearly states, “[a] mere statement of conclusion is inadequate.” The Examiner has cited no rule or MPEP section supporting his conclusion. Therefore the Applicant respectfully requests that the Examiner withdraw the election requirement.

#### SPECIFICATION OBJECTIONS

The Examiner has objected to the abstract of the disclosure because the word “Whereby” in line 15 3 should be part of the previous sentence. To expedite prosecution, the Applicant has amended the abstract as suggested by the Examiner. In addition, the Applicant has corrected other grammatical and typographical errors in the abstract. The Applicant submits that no new matter has been entered with these amendments.

#### CLAIM REJECTIONS

20 35 USC 102 – Nishimoto (GB 2171535)

Claims 1, 2, 4-9, 14-17, 21-24, 27-28 were rejected under 35 USC 102(b) as being anticipated by Nishimoto. In rejecting the claims it is argued that Nishimoto discloses a variable focal length lens system (Fig. 2) for providing an optical system having a plurality of selectable focal powers ranging between f1 and f2. The Examiner argues that Nishimoto’s variable focal length lens 25 system has first and second switchable elements switchable between first and second states wherein there are four distinct pairs of states of the two elements.

The Applicant respectfully traverses the rejection. Claim 1 has been amended to recite that the first and second switchable elements have the same focal length in their respective first states. Nishimoto is devoid of any teaching or suggestion of such a feature. The Applicant submits that

Appl. No. 10/617,572  
Amtd. Dated July 20, 2005

Attorney Docket No.: BAT-102  
Reply to Office Action of March 21, 2005

having a common first-state focal length this feature is a non-trivial feature since it simplifies the design, construction and operation of a digital focus lens system.

In addition, claims 2, 4-9, 14-17 and 27-30 depend from claim 1 and recite additional features therefor. As such, and for the same reasons set forth above, these dependent claims are believed 5 to distinguish over Nishimoto.

Furthermore, the Applicant submits that Nishimoto does not teach or suggest a stack of thin lenses as set forth in claim 5 as amended. The Applicant submits that a stack of thin lenses has a particular meaning as set forth in the specification at page 3, lines 13-26, i.e., that individual lens elements are in optical communication with each other such that each element may contribute to 10 a cumulative optical affect. The elements may be oriented such that their optical axes are generally collinear. Some or all of elements may be positioned in close proximity to adjacent elements. The switchable elements are "similar to thin lenses whereby the standard thin lens approximation formulas may be applicable". Furthermore, a stack of thin lenses is described as referring to a situation where "each element can be approximated as a thin lens and each is in 15 approximate contact with any adjacent elements" (see page 5, line 24 to page 6, line 2). The Applicant submits that Nishimoto is devoid of any teaching or suggestion of such a feature. Instead, Nishimoto shows, e.g., in FIG. 5 that the birefringent lenses 3<sub>1</sub>..3<sub>n</sub> and polarization rotators 2<sub>1</sub>..2<sub>n</sub> are not in contact. As such, for at least this additional reason, Nishimoto does not anticipate claim 5.

20 Furthermore, the Applicant submits that Nishimoto does not teach or suggest setting the state of N switchable elements by coupling a control signal to the N switchable elements wherein a portion of the control signal includes a data stream comprising a control word as set forth in claim 21. Instead, Nishimoto only teaches that "[t]he switches are controlled to be interlocked with each other under the control of a program loaded into a microcomputer or the like." See 25 page 3, lines 15-18. Nishimoto does not teach or suggest how such a program could control the states of all the switches with a single control word as set forth in claim 21. In addition, with respect to claim 22, Nishimoto is devoid of any teaching or suggestion that a control word having an N bit field length can control N switchable elements. The section cited by the Examiner (page 2, lines 120-122) states only that the "switches 5<sub>1</sub>, 5<sub>2</sub>,.. 5<sub>n</sub> are selectively 30 switched to set discrete focal points F1, F2,... FN (where N=2<sup>n</sup>).". This only states the obvious

Appl. No. 10/617,572  
Amtd. Dated July 20, 2005

Attorney Docket No.: BAT-102  
Reply to Office Action of March 21, 2005

fact that the focal point selected depends on the states of the n switches. There is no teaching or suggestion in Nishimoto that a single N-bit word controls the state of all N switches. As such, for at least these additional reasons, Nishimoto does not anticipate claims 21 and 22.

Furthermore, claims 22-24 depend from claim 21 and recite additional features therefor. As such, and for the same reasons set forth above, these dependent claims are believed to distinguish over Nishimoto.

### 35USC 103

The Examiner has rejected claims 10-13 and 18 as being obvious over Nishimoto and claim 3 as being obvious over Nishimoto in view of US Patent 6,356,366 to Popovich. The Applicant respectfully traverses the rejections. As set forth above, the applicant submits that Nishimoto does not teach all the features of claim 1. The Examiner admits that Nishimoto does not teach the additional features of claims 10-13 and 18. Further, the Applicant submits that the Examiner has pointed to no teaching or suggestion Popovich teaches all the features of claim 3 absent the combination with Nishimoto. As such, the Applicant submits that Nishimoto, either by itself or in combination with Popovich, does not render obvious claims 3, 10-13, and 18.

### NEW CLAIMS 29-41

The Applicants submit that new claims 29-41 are distinguishable over the cited prior art of record by virtue of their dependence from claim 1. Furthermore, neither Nishimoto nor Popovich teaches or suggests that the focal lengths of the switchable elements are related according to the formulas set forth in claims 29-34 and 37-41.

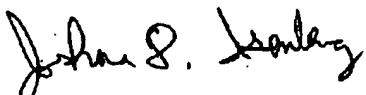
Appl. No. 10/617,572  
Amdt. Dated July 20, 2005

Attorney Docket No.: BAT-102  
Reply to Office Action of March 21, 2005

CONCLUSION

The Applicant submits that, for the reasons set forth above, the restriction requirement is improper and all of the pending claims are allowable. Therefore, the Applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement, examine the 5 withdrawn claims, reconsider the application and point out the allowable subject matter in the next Office Action.

Respectfully submitted,



10 Joshua D. Isenberg  
Reg. No. 41,088  
Attorney of Record

Date: July 20, 2005

15 JDI PATENT  
204 Castro Lane  
Fremont, CA 94539  
tel.: (510) 896-8328  
fax.: (510) 360-9656